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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/822,851	04/09/2004	Matthew D. Nordstrom	005127.00286	2667

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BANNER & WITCOFF, LTD.  
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BOSTON, MA 02109-9601

EXAMINER
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WORRELL JR, LARRY D

ART UNIT	PAPER NUMBER
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3765

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

## Office Action Summary

Application No.

10/822,851

Applicant(s)

NORDSTROM, MATTHEW D.

Examiner

Danny Worrell

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. ____   |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date ____  | 6) <input type="checkbox"/> Other: ____                                     |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claims 1 and 19 the recitation "anatomical high points of a user's body" is indefinite since there is no previous recited basis for such points and since it is unclear as to the points being referenced.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 2, 4-7, 10, 11, 12, 19, 20, 22-25, 28, 29 and 30 insofar as definite are rejected under 35 U.S.C. 102(b) as being anticipated by Feigenbaum et al (4916755).

The disclosure of Feigenbaum et al (4916755) teaches the article of apparel having improved body conformity as claimed including a body of material formed of a stretchable fabric (14) and a stretchable piece of material (16) secured to the body of material and having a size and a shape configured to at least partially cover an area of a user's body between "anatomical high points of the user's body." Re claims 2 and 20, note the embodiment of figure 4a that

shows the piece of material secured to an interior surface. Re claims 4 and 22, note that the material is secured with an adhesive element. Re claim 7 and 25, note the embodiment of figure 3 which shows the piece of material positioned in the lumbar region of the user's back. Re claims 11 and 29, note the additional piece of material shown in the figures.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 8, 9, 13, 17, 26, 27, 31 and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feigenbaum et al (4916755) in view of Itagaki et al (5033116).

Feigenbaum et al (4916755) teaches the invention substantially as claimed as set forth above in the rejection to claim 1 and 19. Feigenbaum et al (4916755) does not teach the additional material is positioned between the breasts or pectoral muscles of wearer. The disclosure of Itagaki et al sets forth an additional triangular shaped material placed in between the breasts of the user. It would have been obvious at the time the invention to one of ordinary skill in the art to which the invention pertains to provide the additional material as a triangular shape between the breasts of the wearer in order to increase the conformity of the swimsuit throughout the upper regions of the wearer.

Claims 3, 14, 21 and 32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feigenbaum et al (4916755).

Feigenbaum et al (4916755) teaches the invention as claimed except for the material being the same namely a blend of polyester and spandex. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the same material since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice. *In re Leshin*, 125 USPQ 416.


Claims 15, 16, 33 and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Feigenbaum et al (4916755) in view of Kudo (4654894).

The disclosure of Feigenbaum et al (4916755) teaches the invention substantially as claimed as indicated above in the rejection to claims 1 and 19. Feigenbaum et al (4916755) does not set forth the specific shape of a diamond with slightly curved sides and a width substantially larger than its height. Kudo teaches an swimsuit having an additional material in the shape of a diamond with a larger width than height. It would have been obvious at the time the invention was made to choose from a number of different shapes the shape of a diamond as shown by Kudo in order to provide the specific control in the area of the stomach.

### **Allowable Subject Matter**

Claims 18 and 36 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

### ***Response to Arguments***

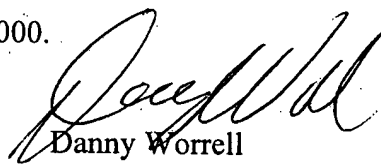
 Applicant's arguments filed 9/22/06 have been fully considered but they are not persuasive. Applicant argues that the location of the stretchable material of Feigenbaum et al is not located "between the anatomical high points". As seen in figures 1-3, the stretchable piece of material is located between anatomical high points of the body to the extent claimed and definite. Applicant has not defined the location other than by using the vague terminology of "high points". Clearly the material shown by Feigenbaum falls within this location as broadly recited.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Danny Worrell whose telephone number is 571/272-4997. The examiner can normally be reached on MON-WED, FRI.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Calvert can be reached on 571/272-4983. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

  
Danny Worrell  
Primary Examiner  
Art Unit 3765

LDW